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Mailed 3/22/07

In re Application of:	:	
Ulrich Speck et al	:	DECISION ON REQUEST FOR
Serial No.: 10/528,577	:	PETITION TO MAKE
Filed: March 21, 2005	:	SPECIAL FOR NEW
Docket: WEICKM-44	:	APPLICATION UNDER 37
Title: MEDICAL DEVICE FOR DISPENSING	:	C.F.R. § 1.102 & M.P.E.P. §
MEDICAMENTS	:	708.02 (VIII)

This is a decision on the petition filed on Aug. 24, 2006 to make the above-identified application special under the accelerated examination procedure set forth in MPEP § 708.02(VIII) and in accordance with 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

In support of the petition, petitioner provides: a) the applicable fee; b) a statement that if an election must be made, applicant would agree to limit examination of this application to the article claims; c) a statement that a search has been made; d) an IDS; and e) a detailed discussion of the references.

For accelerated examination under MPEP § 708.02(VIII) in accordance with 37 C.F.R. § 1.102(d), a showing of the following is required: a) the applicable petition fee; b) all claims are directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, applicant will make an election without traverse; c) a statement that a pre-examination search was made, listing the field of search by class and subclass; d) a copy of each of the references deemed most closely related to the claimed subject matter; and e) a detailed discussion of the references pointing out with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is distinguishable over the references.

The requirements of MPEP § 708.02(VIII)(a-c) are considered to have been met. However, the petition does not meet the requirements of MPEP § 708.02(VIII)(d and e).

Regarding the requirement of MPEP § 708.02(VIII)(d), states that submission of one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record. The IDS statements filed on Aug. 24, 2006 failed to include a copy of References B8, B9, B10 and B15.

Regarding the requirement of MPEP § 708.02(VIII)(e), 37 CFR § 1.111 (b) states “[a] general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.” 37 CFR § 1.111 (c) states in part “the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.” The applicant provides a discussion of some of the references cited but does not point out the particular language that distinguishes the independent claims 1, 24 and 38, filed on Aug. 24, 2006, from these references. The applicant’s general allegations that the invention is patentable over the references run contrary to 37 CFR § 1.111 (b), which does not allow for general allegations. Moreover, petitioner only described some of the references to the present invention. In particular, petitioner merely mentioned the US Patent documents US 5,370,614, US 6,918,927 and US 2004/0073284 in general terms but failed to provide a comparison between all 68 cited prior art documents with at least the independent claims. Each independent claim must be compared with *each* of the cited 68 references, and the patentable novelty in *each* independent claim relative to *each* reference must be clearly pointed out. Because the petition does not point out the specific language in each independent claim that distinguishes over each of the 68 references, the petition fails to meet the requirements of MPEP § 708.02(VIII)(e). For example, the applicant failed to explain any specific limitations in claims 1, 24 and 38 not shown or taught by the cited 68 patent documents and non-patent literature documents.

While Technology Center Directors may have granted petitions that do not comply with the detailed discussion requirement of the Accelerated Examination procedure, Technology Center Director decisions on petitions are not binding precedent of the Patent Examining Corps, and the application of an improper standard in certain cases does not require the Office to continue to apply the improper standard in all cases. See *In re The Boulevard Entertainment, Inc.*, 334 F.3d 1336, 1343, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003).

For the above-mentioned reasons, the petition is dismissed. The application will, therefore, be taken up by the examiner for action in its regular turn.

Any request for reconsideration of this decision must be submitted within 2 (two) months of the date of this decision in order to be considered timely. Any request for reconsideration must provide a detailed discussion of each of the cited 68 references that clearly points out the specific language in each independent claim that distinguishes over the reference.

Application Serial No. 10/528,577
Decision on Petition

Any inquiry regarding this decision should be directed to Henry Yuen, Special Program Examiner, at (571) 272-4856.



Henry C. Yuen,
Special Program Examiner
Technology Center 3700